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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/029,663	12/18/2001	Frans C.M. van Haastest	41419/VGG/P622	5086

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EXAMINER

BELL, KENT L

ART UNIT PAPER NUMBER

1661

DATE MAILED: 01/15/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/029,663

Applicant(s)

van NAASTEST

Examiner

KENT L. BELL

Art Unit

1661

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on application filed 12/18/01.
- 2a) ☐ This action is FINAL.
- 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12/18/01 is/are a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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Drawing Notification

The submitted photographic illustrations filed December 18, 2001 have been objected to by an Official Draftsperson under 35 CFR 1.165(a) for the reasons set forth on the attached PTO-948. By way of explanation, the quality of all the photographic illustrations is poor, i.e. blurry and grainy, and color fidelity is poor as it appears faded or washed (37 CFR 1.84(b)). Further, the margins of all photographic illustrations are not proper (37 CFR 1.84(g)). The top, right, and left margins of Sheet 1 (printed on Hewlett Packard paper) are not proper. The top and left margins of Sheet 1 (printed on plain white copier paper) are not proper. The top, right, and left margins of Sheet 2 (printed on Hewlett Packard paper) are not proper. The top and left margins of Sheet 2 (printed on plain white copier paper) are not proper. In addition, Sheet 1 and 2 (printed on plain white copier paper) contains unwarranted advertising. Further, it appears there are four different photographic illustrations present, not two with duplicate copies.

Further, the drawings should not be sent to the 20231 zip code address for the United States Patent and Trademark Office. Please direct all replies to the United States Patent and Trademark Office via one of the following:

1. Hand carried directly to:

1911 South Clark Place
Crystal Mall One, 7th Floor Receptionist Area
Arlington, Virginia 22202

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2. Mailed to:

U.S. Patent and Trademark Office
P.O. Box 2327
Arlington, Virginia 22202

Objection to the Drawing

The following is a quotation of section (a) of 37 CFR 1.165:

(a) Plant patent drawings are not mechanical drawings and should be artistically and competently executed. Figure numbers and reference characters need not be employed unless required by the Examiner. The drawing must disclose all the distinctive characteristics of the plant capable of visual reproduction.

The drawings are objected to under 37 CFR 1.165(a) as the illustrations of record are not competently and/or artistically executed. The drawings are so out of focus and blurry, they convey no useful information. The flowers and foliage are especially out of focus and the individual tepal and leaf characteristics are not clearly illustrated. In addition, the color fidelity appears to be faded or appears to have a washed out appearance. New photographic illustrations which clearly depict the instant cultivar in its entirety should be made of record in this application. Applicant is reminded that it is the entire plant for which plant protection is being sought, as such, applicant needs to provide description (be it in written or photographic form) for all characteristic plant features capable of same. New photographic illustrations of the instant cultivar as depicted in the instant drawings (Sheets 1 and 2, printed on the Hewlett Packard paper), if artistically and

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competently executed, would clearly show its typical characteristics, i.e. plant habit, flowering habit, foliage, and flowers. While applicant may not consider these features to be the main patentable differences or distinction, they need to be described and/or illustrated so as to provide as complete a botanical description of the plant as is reasonably possible (37 CFR 1.163(a)).

The drawings (Sheets 1 and 2 printed on the plain white copier paper) are further objected to as containing unwarranted advertising.

Objection to the Disclosure

37 CFR 1.163

The following is a quotation of section (a) of 37 CFR 1.163:

(a) The specification must contain as full and complete a disclosure as possible of the plant and the characteristics thereof that distinguish the same over related known varieties, and its antecedents, and must particularly point out where and in what manner the variety of plant has been asexually reproduced. In the case of a newly found plant, the specification must particularly point out the location and character of the area where the plant was discovered.

35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

As specific to United States Plant Patent applications, the specifics of 37 CFR 1.164 (reproduced below) are controlling:

The claim shall be in formal terms to the new and distinct variety of the specified plant as described and illustrated, and may also recite the principal distinguishing characteristics. More than one claim is not permitted.

In plant applications filed under 35 U.S.C 161, the requirements of 35 U.S.C. 112 are limited. The following is a quotation of 35 U.S.C. 162:

No plant patent shall be declared invalid for noncompliance with section 112 of this title if the description is as complete as is reasonably possible. The claim in the specification shall be in formal terms to the plant shown and described.

The disclosure is objected to under 35 CFR 1.163(a) and under 35 U.S.C. 112, first paragraph, because the specification presents less than a full, clear, and complete botanical description of the plant and the characteristics which define same per se and which distinguish the plant from related known cultivars and antecedents.

More Specifically:

A. The disclosure is objected to under 37 CFR 1.121(e) because the Latin name of the genus and species of the claimed plant and Variety Denomination of the claimed plant should be preceded by a heading as set forth in 37 CFR 1.163(c)(4)(5) and 37 CFR 1.163(d). This

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information should be set forth before the “BACKGROUND OF THE INVENTION” section as set forth in 37 CFR 1.163(c).

B. Applicant should set forth in the specification the Genus and species for the instant plant, to the extent known.

C. Page 1, lines 15-17, Even though applicant states “the distinguishing characteristics of the new variety are transmitted through succeeding generations” it doesn’t mean the instant plant reproduces true to type, especially as applicant has stated that the only distinguishing feature of the instant plant is the production of fully double flowers. It is in the realm of possibility that another Clematis plant either known or unknown to the inventor which produces fully double flowers is in existence. Applicant should also state in the specification that the “instant plant reproduces true to type”.

D. Page 2, lines 3-10, Applicant states the illustrations depict “specimen flowers”. The photographic illustrations depict --plants-- of the new variety. Correction is necessary. In addition, applicant should specifically set forth which photographic illustration is being described. The recitations “One figure” and “The other figure” do not clearly set forth which photographic illustration is being described especially as the figures themselves are not labeled as such. In

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addition, it appears applicant has provided four photographic illustrations and has only described two. The two sheets labeled at the top as "Sheet 1 of 2" are not the same and the two sheets labeled at the top as "Sheet 2 of 2" are not the same. Correction and/or clarification is necessary.

E. Page 2, lines 12-16, Applicant should set forth in the specification the age of the plants when described and container size, if grown in a container.

F. Page 2, line 16, Applicant should delete "COLOR" and insert --COLOUR-- as this is the way color is spelled when setting forth or referencing this particular color chart.

G. Page 2, lines 18-20, Applicant should set forth in the specification the instant plant's typical and observed mature diameter.

H. Applicant should set forth in the specification meaningful information relative to the instant plant's stems including the typical and observed stem length, texture, internode length, and coloration with reference to the employed color chart.

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I. Page 2, lines 23 and 24, Applicant sets forth a foliage size but does not state whether the dimensions set forth are for the entire leaf or the leaflets. Applicant should set forth in the specification the typical and observed entire leaf length and width and leaflet length and width.

J. Page 3, lines 3 and 4, Applicant should set forth in the specification additional information relative to the instant plant's leaflets including the typical and observed apex and base descriptors.

K. Page 3, lines 11-13, Applicant should set forth in the specification additional information relative to the instant plant's petioles including the typical and observed petiole length.

L. Page 3, line 14, Applicant should delete "stipples" and insert --stipules--. Correction is necessary.

M. Page 3, line 17-19, Applicant should set forth in the specification color designations for both old and new wood, with reference to the employed color chart.

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N. Applicant should set forth in the specification information relative to the instant plant's flower buds including the typical and observed shape, length, diameter, and coloration with reference to the employed color chart.

O. Page 3, lines 20 and 21, Applicant should set forth in the specification additional information relative to the instant plant's flowers including the typical and observed number of flowers and flower buds per plant per season, flower shape, diameter, depth, and fragrance.

P. Applicant should set forth in the specification meaningful information relative to the instant plant's tepals including the typical and observed number of tepals per flower, length, width, shape, apex, base, and margin descriptors, and coloration (both surfaces) with reference to the employed color chart.

Q. Applicant should set forth in the specification meaningful information relative to the instant plant's sepals including the typical and observed number of sepals per flower, length, width, shape, apex, base, and margin descriptors, and coloration (both surfaces) with reference to the employed color chart.

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R. Applicant should set forth in the specification the typical and observed lastingness of an individual bloom, on the plant.

S. Applicant should set forth in the specification the time it takes to produce a flowering plant.

T. Applicant should set forth in the specification the typical and observed flowering season in a specified location of culture.

U. Page 4, lines 3-7, Applicant states the flowers are “completely double” then states there are no stamens, styles, etc. “visibly present”. The recitation “visibly present” makes it appear that the instant plant may have reproductive organs. Applicant should verify which is the case. If there are no reproductive organs than the specification should state the same. If there are reproductive organs present then applicant should set forth in the specification a detailed botanical description for reproductive organs including stigma, styles, stamens, ovary/ies, pistil number (such as quantity, size and coloration of organs) into the specification with reference to the color chart employed. Applicant should also state whether pollen is produced. If pollen is produced, such should be accounted for by setting forth in the specification the amount produced, i.e. scarce, moderate, abundant, and coloration with reference to the employed color chart.

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The above listing may not be complete. Applicant should carefully review the disclosure and import into same any corrected or additional information which would aid in botanically identifying and/or distinguishing the cultivar for which United States Plant Patent protection is sought.

Claim Rejection

35 U.S.C. 112, 1st & 2nd Paragraphs

Claim 1 is rejected under 35 U.S.C. 112, first and second paragraphs as not being supported by a clear and complete botanical description of the plant for the reasons set forth in the Objection to the Disclosure Section above.

Comments

Due to the amount of revision seen necessary in this application, it is suggested that Applicant file a substitute specification, incorporating all additions, deletions and modifications so as to provide the printer a clean copy at the time of allowance. Applicant should specifically authorize cancellation of the present specification to the same. Further, a clean copy and marked up copy (showing any addition, deletion, and/or modification) of the substitute specification should be submitted.

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Future Correspondence

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Kent L. Bell whose telephone number is (703) 306-3224. The Examiner can normally be reached Monday through Thursday from 6:00 am to 4:30 pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Bruce Campell, can be reached at (703) 308-4205.

The fax phone number for the group is (703) 305-3014 or 308-4242.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

K. L. Bell

**KENT BELL
PRIMARY EXAMINER**

Kent L. Bell